

With respect to the distinctness of Groups I and II, the Examiner states:

"2. The inventions are distinct, each from the other because of the following reasons: Inventions of Group I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Group I can be practiced by hand or in another materially different apparatus." See, paragraph 2, p. 2 of the Office Action, Paper No. 7.

Applicants respectfully traverse the restriction requirement for the reasons set forth below.

As pointed out in the Manual of Patent Examining Procedure (MPEP), a proper restriction between independent and distinct inventions claimed in the same application requires two criteria: (1) the inventions must be independent and distinct *as claimed*, AND (2) there must be a serious burden placed on the Examiner by not requiring restriction. If either criterion is not met, restriction is not proper (see, MPEP § 803). Thus, even if an application contains claims that are independent or distinct, the lack of a serious burden for a search of the subject matter requires that an examination on the merits be carried out on all of the claims without restriction.

As noted in the MPEP:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (MPEP § 803, emphasis added).

Applicants' invention is based on the inventive feature of isolating nucleic acids by immobilizing the nucleic acids on one side of a surface followed by a release (elution) of the immobilized nucleic acids from the same side of the surface on which the nucleic acids were applied and immobilized (see, e.g., p. 5, lines 4-5; p. 12, lines 3-5). The basic steps of this claimed process are recited in independent Claims 1 or alternatively Claim 50.

Applicants have also recognized and taught that one or more steps of Applicants' inventive process may also be carried out by automation. As noted in the disclosure, automation of one or more steps of this process would provide a number of advantages over manual labor including *inter alia* increasing the number of samples processed per run, saving human hours and contact with samples, and preventing contamination and enhancing purity of isolated nucleic acids (see, e.g., p. 4, lines 23-28; p. 11, lines 6-21 of the specification). Nevertheless, although such automation may enhance efficiency of one or more steps, clearly the basic steps of the process are still carried out as recited in Claim 1 or Claim 50.

The claims of Group II either recite that the steps of the method claims are automated (Claims 6-8) or recite an apparatus for carrying out the steps of the method claims (Claims 56-57). Importantly, Claims 6, 7 and 8 are dependent from earlier process claims, and the apparatus of Claims 56 and 57 recite an apparatus expressly adapted to the performance of the method of the earlier claims. Thus, *as claimed*, the subject matter of Group II is inextricably tied to the process of Group I, and the invention as defined in Group II cannot be practiced using a materially different process from that recited in the Group I claims.

Furthermore, given that the claims of Group II are directed to the same inventive features as recited in the Group I claims and are similarly classified, a search of art relevant to Group I would reveal all relevant art concerning Group II and therefore would not place a serious burden on the Examiner. Accordingly, division of Group II claims from the process claims of Group I is unnecessary and improper.

In view of all of the above comments, Applicants respectfully submit that Claims 1-58 are clearly related by the same inventive features, and accordingly Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement of paper no. 7 and examine all of the pending claims together.

Although Applicants believe that restriction of the claims is improper, and without in any way acquiescing or conceding to the reasons for the restriction requirement set forth in the Office Action, but in order to be fully responsive to the Office Action, Applicants provisionally elect for examination the claims of Group I, i.e., Claims 1-5, 9-55, and 58.

Respectfully submitted,

Leon R. Yankwich, Registration No. 30,237
Thomas R. Berka, Ph.D., Registration No. 39,606
Attorneys for Applicants
YANKWICH & ASSOCIATES
130 Bishop Allen Drive
Cambridge, Massachusetts 02139
telephone: (617) 491-4343
telefax: (617) 491-8801



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November 1, 2001

Date of mailing and signature

Stephanie L. Leicht
Stephanie L. Leicht